

REMARKS

This Amendment addresses the issues raised by the Examiner in the Office Action mailed February 8, 2005. Initially, Applicants would like to thank the Examiner for the careful consideration given this case. In view of the above amendments and the following remarks, Applicants feel that all outstanding issues have been addressed and prompt allowance of all remaining claims is respectfully requested.

Applicants acknowledge the Election/Restriction discussion made by the Examiner at the outset of the Office Action. Although Applicants believe that the Examiner's rationale underlying the restriction is arbitrary and contrary to all authority, Applicants wish to bring the present prosecution to a successful conclusion as soon as practicable. Toward that end, Applicants have canceled the non-elected claims (Claims 2-8 and 19-22) from the present application without prejudice as to their being reintroduced in a related application.

Claim Rejection 35 U.S.C. § 112

Applicants note the Examiner's rejection related to the typographical error in Claim 17. This typographical error has been corrected by the above amendment. This amendment is fully supported by the claims as originally filed and throughout the specification.

Claim Rejections 35 U.S.C. § 102

The Examiner rejected Claims 9, 10, 12, 13, 15, 17 and 18 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,520,569 to Endoh ("Endoh"). The Examiner goes on to attempt to read Endoh on the asserted claims, including claims that include: (1) an "anchor device" to secure the lateral device to the inner walls of a lateral pipe that intersects a main pipe; and (2) an onboard

power source on the lateral device to power the device from *within* the lateral pipe. Tellingly, when the Examiner attempts to read these two elements on Endoh, the Examiner fails to provide a cite to any portion of Endoh which shows these claimed features. This is not surprising because Endoh fails to teach or suggest any such elements.

As discussed in the reference, Endoh teaches a cutting device for cutting through the lining of a main pipe after a relining process. However, it is clear that the Endoh device is inserted into the main pipe after relining, not into the lateral pipe before a relining process (the relining process trapping the lateral device up in the lateral pipe). Since the Endoh device operates from within the *main* pipe, it does not include (and would not require or benefit from) the claimed anchor device that secures the lateral device to the walls of a lateral pipe from within the lateral. Further, because the claimed lateral device is cut off from the main pipe during relining, the lateral device must have its own onboard power – a claimed element that is nowhere to be found in Endoh.

Although Claim 9 (and therefore the other dependent claims) clearly distinguished over Endoh as originally presented, Applicants have chosen to amend Claim 9 to even more clearly distinguish over Endoh and the other references. Claim 9 now includes an anchor device to secure the lateral device to the walls of the lateral and further includes a local power supply onboard said lateral device to provide power to said work tool (such as a cutter). These claimed features allow the lateral device to be inserted into the lateral before relining and allow the cutting (or other work) process to be performed from the lateral side of the relined pipe (because of the onboard power source). Endoh, on the other hand, is merely a conventional main pipe robot that performs cutting from the main pipe (see Col. 6, lines 14-46) and does not teach or suggest (and would not benefit from) the claimed features of the invention.

The Examiner also rejected Claims 1, 9, 16 and 17 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,695,013 to Warren ("Warren"). Again, in positing this rejection, the Examiner does not give proper weight to the actual language of the claims as written. Instead, the Examiner attempts to read out real limitations of the claims by, for example, equating the "lateral device" with the "work tool (16)." This is, of course, completely improper. It is clear that the claims require more than just a work tool being pushed into a lateral pipe from a device in the main pipe. Instead, the claims are drawn to a lateral device (Claim 9 *et seq.*) and method of using the device (Claim 1) that is actually inserted into a lateral pipe and performs work within the lateral pipe (or from the lateral pipe side of the relined main pipe). As with Endoh, Warren simply does not teach this concept or the claimed features directed to accomplishing this task.

Warren's proposed method and device for lining lateral pipes involves a pipe liner and bladder being inflated into the lateral pipe from a device in the main pipe (see Col 7, lines 5-10). In the current claim (e.g., Claims 1, 9, and 16) the lateral device that is anchored provides the power to drag the liner into position as opposed to using a device from the mainline to inflate the liner into position (claimed as onboard power). This provides the opportunity to utilize several of the lateral devices with their liners all deployed by a single delivery device and working in parallel. While in Warren's proposed solution of deploying the liner from the main line, each lateral would need a mainline device for deployment and consecutive laterals could only be lined serially, one after the other.

In short, Warren does not add anything to the discussion (and missing elements) of Endoh. There is simply nothing in these references that teaches or suggests key areas claimed in the present application (both originally and as amended).

Claim Rejections § 103(a)

The Examiner also rejected Claims 11 and 14 under 35 U.S.C. §103(a) as being unpatentable over Endoh in light of U.S. Patent No. 5,318,395. The Examiner argues that Endoh teaches all elements of these claims except for “a rotating arm supporting rotary bit cutting tool” or the “spring biased/tensioning against the inner wall of the pipe.” In the first instance, as explained above, because Endoh does not teach or suggest the invention claimed in the independent claim from which Claims 11 and 14 depend, this combination of references also does not render these two claims unpatentable.

Moreover, the Examiner does not even address the language of Claim 14. Claim 14 suggests a grinding device which is spring loaded to adjust the cutting diameter and is significantly different from the rotary tool with a side nozzle proposed by Driver (Figs. 6 –11, Col 6 lines 20-24). For at least these reasons, Claims 11 and 14, as well as the other claims discussed above, distinguish over the cited art.

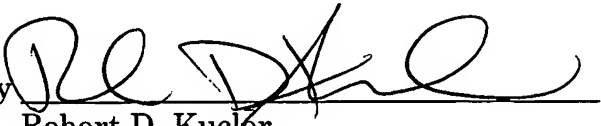
New Claims 23-31

Since Applicants cancelled claims directed to the non-elected species, Applicants have included new Claims 23-31 which are similar in scope to previously presented claims 9- 18. For example, these new claims are directed to an “untethered” lateral device – completely different than the main pipe devices of Endoh and Warren. For each of the reasons discussed above, these claims are also allowable over the cited art and all art known to the Applicants at this time.

The above claim amendments and accompanying remarks address each and every concern raised by the Examiner in the Office Action. Applicants believe that all remaining claims of the present invention are now in condition for final allowance. If the Examiner feels that any issues remain outstanding, the Examiner is encouraged to contact Applicant’s attorney at the contact information below.

Respectfully submitted,

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